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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/672,401      | 09/26/2003  | Steven E. Guzorek    | 23635-218007        | 9149             |

7590 09/03/2004

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EXAMINER

BASICHAS, ALFRED

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3749

DATE MAILED: 09/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/672,401

Applicant(s)

GUZOREK, STEVEN E.

Examiner

Alfred Basichas

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 6-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/08/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5, drawn to a damper assembly, classified in class 126, subclass 285 R.
- II. Claims 6-10, drawn to a hot water heater, classified in class 122, subclass 13.01.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Group II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because a damper not requiring an axle and pinion could be used. The subcombination has separate utility such as a damper to operate in the flue of a chimney.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Patrick Richards on June 15, 2004 a provisional election was made with traverse to prosecute the invention of group I, claims 1-5. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6-10 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Gaw  
June 15, 2004

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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3. Claims 1, 3, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dameworth (5,911,217) in view of Swenson (4,266,929). Dameworth discloses substantially all of the claimed limitation including, among other things, a drive unit 94, an axle 98 having a pinion/gear 114 (clearly drawn as such and known to those skilled in the art), and a generally circular damper 70. Such an arrangement has the clear and obvious benefit of providing for effective and efficient drive mechanism for venting a heating device. Nevertheless, Dameworth does not specifically recite the type of drive unit. Swenson teaches a fluid actuated damper in which the drive unit 60 includes a diaphragm 68 having a first and second positions (figs. 2,3) for driving the damper between a first and second positions via a linkage system 92,94,96. Swenson does not specifically recite using a rack and pinion system for transferring mechanical motion between the diaphragm and the damper. Official Notice is given that the functional equivalence and interchangeability of a rack and pinion system and a linkage system is old and well known in the art. Both systems are effective and efficient and the selection of one over the other is simply based on availability and cost of manufacture.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the drive mechanism of Swenson and a rack and pinion system motion into the invention disclosed by Dameworth, so as to provide for effective and efficient drive mechanism for venting and based on availability and cost of manufacture, respectively.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dameworth (5,911,217) in view of Swenson (4,266,929) and further in view of Benson

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(4,488,853). Dameworth and Swenson disclose substantially all of the claimed limitation, but fail to specifically recite the use of a bellows. Benson teaches that diaphragms and bellows are equivalent and interchangeable (see at least col. 17, lines 15-17). The use of one or the other is an obvious modification based on design choice, and depends on capacity and the like. In view of the absence of criticality for this particular design, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the use of a bellows as taught by Benson into the invention disclosed by the combination of Dameworth in view of Swenson, so as to provide for the desired capacity.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dameworth (5,911,217) in view of Swenson (4,266,929) and further in view of Johnson (1,991,557). Dameworth and Swenson disclose substantially all of the claimed limitation, but fail to specifically recite a non-central pivot point. Johnson teaches a damper 64 for a water heater with an offset pivot point that provides for better balance and therefore greater effectiveness and efficiency (see at least page 2, lines 54-69). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the use of offsetting the pivot point as taught by Johnson into the invention disclosed by the combination of Dameworth in view of Swenson, so as to provide for greater balance and efficiency.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alfred Basichas whose telephone number is 703 306 3476. The examiner can normally be reached on Monday through Friday during regular business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ira Lazarus can be reached on 703 308 1935. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0861.

September 1, 2004

  
Alfred Basichas  
Primary Examiner  
703 306 3476